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10/812,266	03/29/2004	Melissa Silvestro	EMC-012 (EMC-04-014)	2765
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GUERIN & RODRIGUEZ, LLP 5 MOUNT ROYAL AVENUE MOUNT ROYAL OFFICE PARK MARLBOROUGH, MA 01752			SAETHER, FLEMMING	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/812,266
Filing Date: March 29, 2004
Appellant(s): SILVESTRO ET AL.

MAILED

DEC 15 2005

GROUP 3600

Michael A. Rodriguez
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/5/2005 appealing from the Office action mailed 3/2/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,746,193

Drake

6-2004

Applicants' admitted prior art (APA), paragraph [0003] of the application.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1, 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants admitted prior art (APA) in view of US Patent No. 6,746,193 issued to Drake. The APA discloses that it is known to use screws in combination with round type Electronics Industry Association Standard mounting rail and, square type Universal Mounting rail according to NEMA standards but, concedes that separate screws would be required for each type of mounting. Drake teaches to provide a shoulder (110) to a fastener such that the same fastener could be used in either a round type or square type mounting rail. The shoulder being sized to fit closely with the square hole (see Fig. 6) and rest upon the surface of the surface of the round hole. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the screw of the APA with a shoulder as disclosed in Drake for the same economic reasons

as described therein. Once the combination was made, the shoulder would be with the claimed dimensions in order to fit closely within the square opening.

(10) Response to Argument

Initially, the examiner states agreement with appellant's understanding of the reference to Drake (US 6,746,193).

In arguing claim 1, applicants correctly points out the rejection is under 35 U.S.C. 103(a) and not under section 35 U.S.C 102 and concludes that such is "indicative of the uniqueness of applicant's invention". In response, the appellants' are correct that the 35 U.S.C. 103 rejection, by definition, means the claims are unique but, that uniqueness can only be associated with any single reference. Indeed, the rejection being under 35 U.S.C. 103 means the claims are obvious. The examiner concedes that no single reference teaches all the features of the claims but, that in no way implies that the claims are not obvious.

Appellants' admit that the location surface of Drake (shown at 110) "bears similarity" to the stepped portion of the instant invention but, that the examiner is failing to consider the remainder of the reference in combination with the screw of the appellants' admitted prior art (APA). In response, the examiner understands that it would be improper to select a single feature of a reference while ignoring the rest. However, this is not the case in regards to Drake because while Drake is a cage nut as

opposed to the screw of the APA both are fasteners in the same environment for the same purpose. Furthermore, it must be emphasized that it is the location surface which is the crux of the invention to Drake enabling it to achieve its stated objectives. As with the instant invention, the novelty of Drake over the prior art is in the location portion and not in the fact that it is a cage nut. Indeed, neither the instant application nor Drake implies that the screw nor caged nut in and of itself is novel and both rely on the stepped portion and location surface respectively for distinguishing over the prior art.

Appellants' argue that since there are two screws disclosed in the APA, one for each type of hole, that the examiner is unclear as to which of the screws is being modified. In response, it is irrelevant which of the screws is modified since either one could be modified to include the stepped portion because once the combination was made, there would only be a single screw which would be operable for both type of holes.

Appellants' argue that the simplicity of the invention is being confused with obviousness. In response, and to the contrary, the examiner contends that it is the simplicity which leads to obviousness. Indeed, the person of ordinary skill in the art can easily recognize the advantageous provided by the location portion of Drake would be applicable to other fasteners. Even Drake recognized the simplicity of the art by indicating simply that "generic principles herein may be applied to other embodiments" (column 2, line 28-29).

Appellants admit being faced with the same problem as Drake but, that faced with the same problem the parties' devised different solutions. Appellants' contends that Drake's solution of using a cage nut differs from appellant solution of using a screw. In responding, Drake's solution is not in the cage nut as evidenced by the cage nut being disclosed as prior art. Instead, Drake's solution or "generic principles" is the locating surface because it is that which distinguishes the cage nut of Drake from the cage nut of prior art. The examiner agrees the problem being solved is the same, but the examiner contends that so is the solution. Both Drake and appellants' came to the same solution specifically: that a locating surface or stepped surface, respectively, would make the fastener able to accommodate racks having both the square and round holes thus avoiding the wasteful requirement of providing unnecessary fasteners.

Appellants indicate that their solution of using a screw is more advantageous for some types of mounting rails. In response, the examiner agrees that a screw would more advantageous for certain rails. However, as mentioned above, the invention is not the screw. Even appellants' own disclosure of the Background makes is clear that it is common to use screws in mounting rails (paragraph [0003] lines 7-9). Therefore, the fact that the instant application is directed to screw whereas Drake is directed to a cage nut which, although different, is an obvious difference.

Appellants' question that due to the simplicity of the invention why did Drake not recognize the solution found by appellants. In response, as noted above Drake did find the solution and it was found prior to appellants. But, for the sake of argument, even assuming the solution were the screw, the disclosure to Drake makes it clear that the his invention is not limited to the cage nut. See column 2, lines 26-32 and column 4, lines 1-8. Clearly, Drake does intend to limit the "generic principles" to solely a cage nut and another of embodiment of the "generic principles" would be to a screw since, as disclosed by appellants, a screw is commonly used in the same application as the cage nut (paragraph [0003]). Drake simply cannot and, need not, disclose all the possible embodiments which would benefit for the "generic principles" disclosed therein.

Appellants' argues that in some cases it would not be common knowledge to interchange nut and bolts and notes that the examiner has failed to provide any examples. In response, the examiner agrees that in some applications nuts and bolts would not be interchangeable, however the application of Drake is used is not one of those applications. In fact appellants' own disclosure provides evidence that in the application associated with Drake, specifically mounting computer systems to racks, both nuts and bolts are well known. Paragraph [0003] of appellants' background is again referred where it list that both screws and nuts are commonly known to mount computers to rails. Appellants add that the complexity of Drake teaches away form any modification but, the rejection is not looking to replace only the nut of Drake but the

entire cage and nut thus there would be no more complexity than already associated the screw of the APA.

Appellants separately argues claim 2 because claim 2 requires the stepped portion to have a circular shape and the reference to Drake does not disclose the circular shape since Drake describes the locating surface (which is equated to the claimed stepped portion) as “preferably square shaped” so as to fit snugly into a square hole. In response, it should be emphasized that the square shape is described as being *preferred* thus leaving open the possibility of other shapes which when taken in conjunction with that “[v]arious modification to the preferred embodiment will be readily apparent” (column 2, lines 26-27) clearly leaves open the possibility of other shapes. Admittedly, as further argued by appellant, the circular shape would not prevent the nut from rotation as Drake discloses of the square shape but, once combined with the screw, one would not even want the screw to be rotationally fixed. The rejection is not looking to change the shape of the location portion on the nut to be circular but, instead is modifying the location portion once combined with the screw to be circular so that the screw could continue to operate as intended.

Appellant separately argues that claim 9 because claim 9 additionally requires a range of diameters. In response, as noted in the above rejection, the combination would have dimensions within the claimed range in order to be operable. In other

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words, since the resulting fastener of the combination of the APA and Drake would be for the purpose of mounting computer equipment in standard dimensioned round and square holes, the dimension fastener would obviously be selected to operable with the associated holes.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Flemming Saether


Flemming Saether
Primary Examiner

Conferees:

Judy Swann 

Daniel Stodola 